

### **REMARKS**

Claims 1-10 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,688,227 to Zerillo (“Zerillo”) in view of U.S. Patent No. 6,729,235 to Kerr (“Kerr”). Applicants respectfully traverse this rejection. In view of the following remarks, reconsideration and withdrawal of all grounds of rejection are respectfully requested.

It is well settled that establishing obviousness requires a showing that the prior art provides every limitation of a claim and the invention as a whole. See M.P.E.P. §§ 2142, 2143. As a result, a reference, or combination of references, that does not teach or fairly suggest the invention as a whole cannot render that claim obvious. See, e.g., M.P.E.P. § 2141.02. Also, to modify or combine references, there must be some suggestion or motivation to do so in the reference itself or in the knowledge generally available to one of ordinary skill in the art that lies outside the disclosure of the patent application. See, e.g., M.P.E.P. §2142. Absent this motivation, a rejection under 35 U.S.C. § 103(a) is improper.

Applicants respectfully submit that a prima facie case of obviousness is not established with respect to claims 1-10, because neither Zerillo nor Kerr, alone or in proper combination, teaches or suggests all the limitations of these claims.

Briefly, Zerillo appears to disclose a retention device for securing a recording medium that is releasably attached to a rotatable, magnetically susceptible cylinder. See Zerillo, column 2, lines 6-13 and 27-52. As recognized in the Office action, Zerillo does not teach or suggest a retention device having “a curved surface complementary to a curvature of the cylinder” as recited in Applicants’ independent claims 1 and 6, and claims 2-5 and 7-10, dependent therefrom.

Turning to Kerr, Applicants respectfully submit that the disclosure of this reference fails to cure the deficiencies of Zerillo with respect to independent claims 1 and 6, because Kerr also does not disclose a retention device that includes “*a curved surface complementary to a curvature of the cylinder.*”

Kerr discloses a material clamp (50) for holding sheet material (36) to a rotatable drum (28). The material clamp is fixedly held above the surface of the drum, with the sheet material being held against the inner surface of the material clamp by a slide. The slide can extend outwards from the surface of the drum to raise the sheet material from the surface of the drum and hold it against the retaining surface of the material clamp. See Kerr, col. 2, lines 19-64.

Applicants respectfully submit that Kerr is *silent* with respect to the shape of the inner surface the retention device, and, in particular, Kerr does not mention a retention device with “*a curved surface complementary to a curvature of the cylinder.*”

In particular, Kerr discloses a retainer device (52) and boss (54), which maintains a retaining surface (56, 57) radially outward of an outer surface (38) of an imaging drum (28). There is no mention in the disclosure Kerr of the retention surface being curved in any way. Consistent with this omission, the retaining surface (56), as shown at least in Figures 3a-8a, 8c, and 9a-11b, and the retaining surfaces (56, 57), as shown together at least in Figures 14 and 15b, are depicted as flat, straight surfaces that *do not* follow the curvature of the drum. For example, Figures 14 and 15b show a configuration with both retaining surfaces (56) and (57). In both drawings, the retaining surfaces (56, 57), i.e., the surfaces disposed nearest the drum and used to contact the sheet material, are flat. In Figure 14, the surfaces (56) and (57) define a single horizontal path, while in Figure 15b, the flat surfaces (56) and (57) are angled slightly to the horizontal plane. Neither of these configurations, however, involves a retaining surface with “*a curved surface complementary to a curvature of the cylinder.*” Furthermore, Figures 2a and 12 do not contradict the above-mentioned figures, but merely present a different perspective of the same retention device having a surface that is flat and straight.

Indeed, this lack of disclosure of a non-flat surface does not come as a surprise, because there is simply no need for the retention surface of Kerr to be curved and “*complementary to a curvature of the cylinder.*” In fact, Applicants respectfully submit that providing a curved surface for the retention surface may be detrimental to the performance of Kerr’s apparatus, as a curved surface would reduce the contact area between a flat outer surface of the radially extendable slide and the inner surface of the material clamp. Curving the surface of the retention

device may require a complementary curvature for the slide to better secure the sheet material therebetween, which would unnecessarily increase the cost of the apparatus.

Zerillo in combination with Kerr, therefore, does not teach or suggest a retention surface having "*a curved surface complementary to a curvature of the cylinder*," as required by Applicants' claims. For at least this reason, Applicants respectfully submit that independents claim 1 and 6 are allowable over Zerillo in view of Kerr. Because claims 2-5 and 7-10 depend, either directly or indirectly, from independent claims 1 and 6 respectively, and include all of the limitations thereof, Applicants respectfully submit that these claims are allowable as well. Accordingly, Applicants respectfully request reconsideration and withdrawal of the rejection of claims 1-10 under 35 U.S.C. § 103(a) as being unpatentable over Zerillo in view of Kerr.


### CONCLUSION

In view of the foregoing, Applicants respectfully request reconsideration, withdrawal of all grounds of rejection, and allowance of claims 1-10 in due course. The Examiner is invited to contact the Applicants' undersigned representative by telephone at the number listed below to discuss any outstanding issues.

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Respectfully submitted,

  
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